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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,840	05/01/2001	Guy Alexander Tom Middleton	5582-2	4985

7590

01/16/2004

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EXAMINER

ROSWELL, MICHAEL

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/846,840

Applicant(s)

MIDDLETON ET AL.

Examiner

Michael Roswell

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on February 8, 2001. It is noted, however, that applicant has not filed a certified copy of the 0103130.1 application as required by 35 U.S.C. 119(b).

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. A substitute specification and substitute claims in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) are required. A statement that they contain no new matter must accompany the substitute specification and substitute claims filed.

3. The specification and claims are objected to for containing such words as "characterised", "programme", and "programmes".

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Claims 1 and 5 recite the limitation "servers" in the fifth line of claim 1 and the sixth line of claim 5. There is insufficient antecedent basis for this limitation in the claims.

6. As a result, Claims 1 and 5 are rejected, and dependent claims 2-4 are also rejected.

7. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim contains the combination "and/or", the use of which renders the claim indefinite.

8. As a result, dependent claim 4 is also rejected.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenner et al (U.S. Patent No. 5,956,716).

11. In regards to claim 1, Kenner et al describe a method of viewing a sequence of media clips wherein a local user connected to a network of one or more servers containing the media files consecutively plays the selected content (Column 4, Lines 36-46). The primary server is able to decode and play the files using the Primary Index Manager and Data Sequencing Interface disclosed by Kenner et al (Column 12, Lines 10-13 and Column 20, Lines 22-32). The user is able to create a play list of files in a particular order and specify a number of variables relevant to each file (Column 21, Lines 43-46 and Column 5, Lines 3-7). The server software retrieves the selected files and plays them through a viewer located on the local machine (Column 4, Lines 43-46).

12. In regards to claim 2, Kenner et al have been shown *supra* to teach a method of viewing a sequence of media clips similar to applicant's claim 1. Addition, amendment, and deletion of files from the play list and play variables is handled by the Search and Retrieval Unit disclosed by Kenner et al (Column 5, Lines 3-7). Kenner et al further disclose the viewing of selected media through a browser plug-in (Column 21, Lines 22-25).

13. In regards to claim 3, Kenner et al have been shown *supra* to describe a method for addition, amendment, and deletion of media files and variables and the playing of the media through a browser plug-in. Kenner et al also teach the use of a user identifier (Column 21, Lines 40-43) and password to establish relevant user access rights to a server or specific files or variables defined by the user (Column 34, Lines 45-48).

14. In regards to claim 4, Kenner et al have been shown *supra* to disclose a method for viewing a sequence of media clips wherein the user is required to enter an identifier

and password to access specific files or servers. Kenner et al also show the linking of a user identifier to a relevant user database to ensure sequences created by the user are accessible (Column 21, Lines 40-46 and Column 34, Lines 45-48).

15. In regards to claim 5, Kenner et al disclose the use of a computer program to execute their method for viewing a sequence of media clips (Column 7, Lines 36-38). Kenner et al also describe a method of viewing a sequence of media clips wherein a local user connected to a network of one or more servers containing the media files consecutively plays the selected content (Column 4, Lines 36-46). The primary server is able to decode and play the files using the Primary Index Manager and Data Sequencing Interface disclosed by Kenner et al (Column 12, Lines 10-13 and Column 20, Lines 22-32). The user is able to create a play list of files in a particular order and specify a number of variables relevant to each file (Column 21, Lines 43-46 and Column 5, Lines 3-7). The server software retrieves the selected files and plays them through a viewer located on the local machine (Column 4, Lines 43-46).

### ***Conclusion***

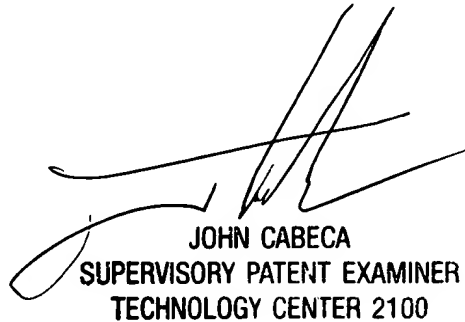
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,564,380 to Murphy, and U.S. Patent No. 6,496,681 to Linton disclose inventions relevant to the field of media editing and are closely related to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (703) 305-5914. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-9731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

Michael Roswell  
1/2/2004



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100